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10/586,128	07/17/2006	Dominique Quesselaire	09669/092001	1798

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EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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02/18/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/586,128	Applicant(s) QUESSELAIRE ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the amendments to the claims and remarks filed on 20 November 2009 (“09 Nov Response”), and to the remarks filed on 13 August 2009 (“09 Aug Response”).
2. Claims 13, 14, and 16-20 are currently pending and have been examined.
3. This Office Action is given Paper No. 20100211. This Paper No. is for reference purposes only.

Restrictions

4. The restriction requirement of the previous Office Action, mailed on 26 October 2009, is hereby withdrawn. The restriction is withdrawn because Applicant cancelled claims drawn to the non-elected inventions. Because Applicant has cancelled the claims, it is impossible for the restriction be maintained.

Claim Rejections - 35 USC §112, Second Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claim 13, 14, and 16-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

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Regarding Claim 13

7. Claim 13 is indefinite because it is unclear to one of ordinary skill in the art whether Applicants are claiming the subcombination of a “merchant transaction terminal” or the combination of a “merchant transaction terminal” and a “virtual terminal server.”

8. If it is Applicants’ intent to claim only the subcombination, the body of the claims must be amended to remove any positive recitation of the combination. If it is Applicants’ intent to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim. For the latter, the Examiner recommends claiming “a system.” This applies to any dependent claims as well.

9. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §103

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13, 14, and 16-20, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Wilkes et al. (U.S. 2005/0097015 A1) (“Wilkes”), in view of Goldthwaite et al. (U.S. 2004/0176134 A1) (“Goldthwaite”).

Regarding Claim 13

12. Wilkes discloses:

A merchant transaction terminal (“ambiguous device **16**” (*e.g.*, “telephone **42**”)) comprising: a human interface module comprising a keypad (“keypad” – see at least ¶ 0053; see also fig. 7), a display (see fig. 7), a card reader (“card swiper” – see at least ¶ 0054), a first processing unit (*inherent* to the ambiguous device (*e.g.*, “networked computer” – see ¶ 0037)) and an internal bus (*inherent* to the ambiguous device (*e.g.*, “networked computer” – see ¶ 0037)) for connecting the keypad, the display, the card reader and the first processing unit, wherein the keypad is configured to receive input of an amount of a transaction (see at least ¶ 0053 for discussion of keying in monetary amount), and wherein the card reader is configured to read a payment card to obtain payment card data from the payment card (¶ 0065), and a subscriber identity module (SIM) card (“SIM card **44**”),

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wherein the merchant transaction terminal is configured to process the transaction, wherein processing the transaction comprises: receiving the payment card data and the amount from the human interface module (“transaction data is encoded in a data structure **52**” – see ¶ 0060; see also fig. 6; “external device... is configured to encode all or part of data structure **52**” – see ¶ 0065, external device and/or phone must receive transaction data from keypad and card swiper), and communicating the payment card data and the amount (see ¶ 0060 for discussion on transmitting data structure; and “telephone **42** transmits transaction request **10** by generating a data structure” – see ¶ 0062) to a virtual terminal server (“processor **18**” (*e.g.*, HLR **46**)).

13. Wilkes does not directly disclose that the SIM card comprises a scheduler to process the transaction.

14. Goldthwaite teaches a SIM card (“SIM **126**”) comprising a scheduler (“mobile transaction client application **125**” – see ¶ 0027) to process a transaction by receiving and transmitting transaction data to a server.

15. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the SIM card of Wilkes to comprise a scheduler, as taught by Goldthwaite, to execute the transaction processing, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claims 14 and 16-20

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16. The combination of Wilkes and Goldthwaite disclose the limitations of claim 13, as shown above, and further disclose the limitations of:

Claim 14: The merchant transaction terminal of claim 13, wherein the merchant transaction terminal is connected to the virtual terminal server through a telecommunication network, and wherein the virtual terminal server is connected to an information processing system of a bank (Wilkes, see at least fig. 1 with associated text);

Claim 16: The merchant transaction terminal of claim 14, wherein the virtual terminal server is connected to a transaction service provider host (Wilkes, see at least fig. 1 with associated text);

Claim 17: The merchant transaction terminal of claim 14, wherein the virtual terminal server comprises a security module for performing secure communication with the scheduler (Goldthwaite, fig. 2 with associated text);

Claim 18: The merchant transaction terminal of claim 13, wherein the human interface module further comprises a printer (Goldthwaite, ¶ 0031);

Claim 19: The merchant transaction terminal of claim 13, wherein the SIM card is located in a mobile device (Wilkes, ¶ 0037; and Goldthwaite, ¶ 0027), wherein the SIM card uses a processing unit and a communication unit on the mobile device to process the transaction (see at least Goldthwaite, fig. 5 with associated text);

Claim 20: The merchant transaction terminal of claim 19, wherein the mobile device is directly connected to the human interface module (Wilkes, see at least fig. 7 with associated text).

Response to Arguments

17. Applicants' arguments with respect to the examined claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).

19. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
February 11, 2010

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621